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No. 15-866

IN THE

Supreme Court of the United States

STAR ATHLETICA, L.L.C., *Petitioner*,

v.

VARSITY BRANDS, INC., VARSITY SPIRIT CORPORATION, AND VARSITY SPIRIT FASHIONS & SUPPLIES, INC., *Respondents*.

On Writ Of Certiorari To The United States Court Of Appeals For The Sixth Circuit

BRIEF FOR THE PETITIONER

STEVEN M. CROSBY
THE FELDMAN LAW GROUP
220 East 42nd St., Ste. 3304
New York, NY 10017

MICHAEL F RAFFERTY
EMILY HAMM HUSETH
HARRIS SHELTON HANOVER WALSH, P.L.L.C.
One Commerce Sq., Ste. 2700
Memphis, TN 38103-2555

JOHN J. BURSCH
Counsel of Record
MATTHEW T. NELSON
CONOR B. DUGAN
WARNER NORCROSS & JUDD LLP
900 Fifth Third Center
111 Lyon Street, N.W.
Grand Rapids, MI 49503
(616) 752-2000
jbursch@wnj.com

Counsel for Petitioner

QUESTION PRESENTED

Under the Copyright Act, "the design of a useful article" such as a chair, a dress, or a uniform cannot be copyrighted. 17 U.S.C. § 101. The design of the article's component features or elements cannot be copyrighted either, unless capable of being "identified separately from, and . . . existing independently of, the utilitarian aspects of the article." *Id.* Circuit courts, the Copyright Office, and academics have proposed at least nine different tests to analyze this separability. The Sixth Circuit rejected them all and created a tenth. The question presented is:

What is the appropriate test to determine when a feature of the design of a useful article is protectable under § 101 of the Copyright Act?

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE

There are no parties to the proceedings other than those listed in the caption. Petitioner is Star Athletica, L.L.C. Respondents are Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashion & Supplies, Inc.

Petitioner Star Athletica, L.L.C., does not have a parent corporation, and no publicly traded corporation owns a 10% or greater interest in the company.

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OPINIONS BELOW

The United States Court of Appeals for the Sixth Circuit's opinion, Pet. App. 1a–57a, is reported at 799 F.3d 468. The denial of rehearing en banc, Pet. App. 79a, is unreported. The United States District Court for the Western District of Tennessee's opinion, Pet. App. 58a–78a, is not reported but is available at 2014 WL 819422.

JURISDICTION

The district court had federal-question jurisdiction under 28 U.S.C. § 1331, and the court of appeals had jurisdiction under 28 U.S.C. § 1291. The court of appeals filed its opinion on August 19, 2015, and denied a petition for rehearing en banc on October 7, 2015. Star Athletica filed a petition for certiorari on January 5, 2016, and the Court granted the petition on May 2, 2016. The Court's jurisdiction rests on 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 101 of the Copyright Act of 1976, 17 U.S.C. § 101, states, in pertinent part:

> Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:
>
> * * *
>
> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; *the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*
>
> * * *
>
> *A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article"* [Emphasis added.]

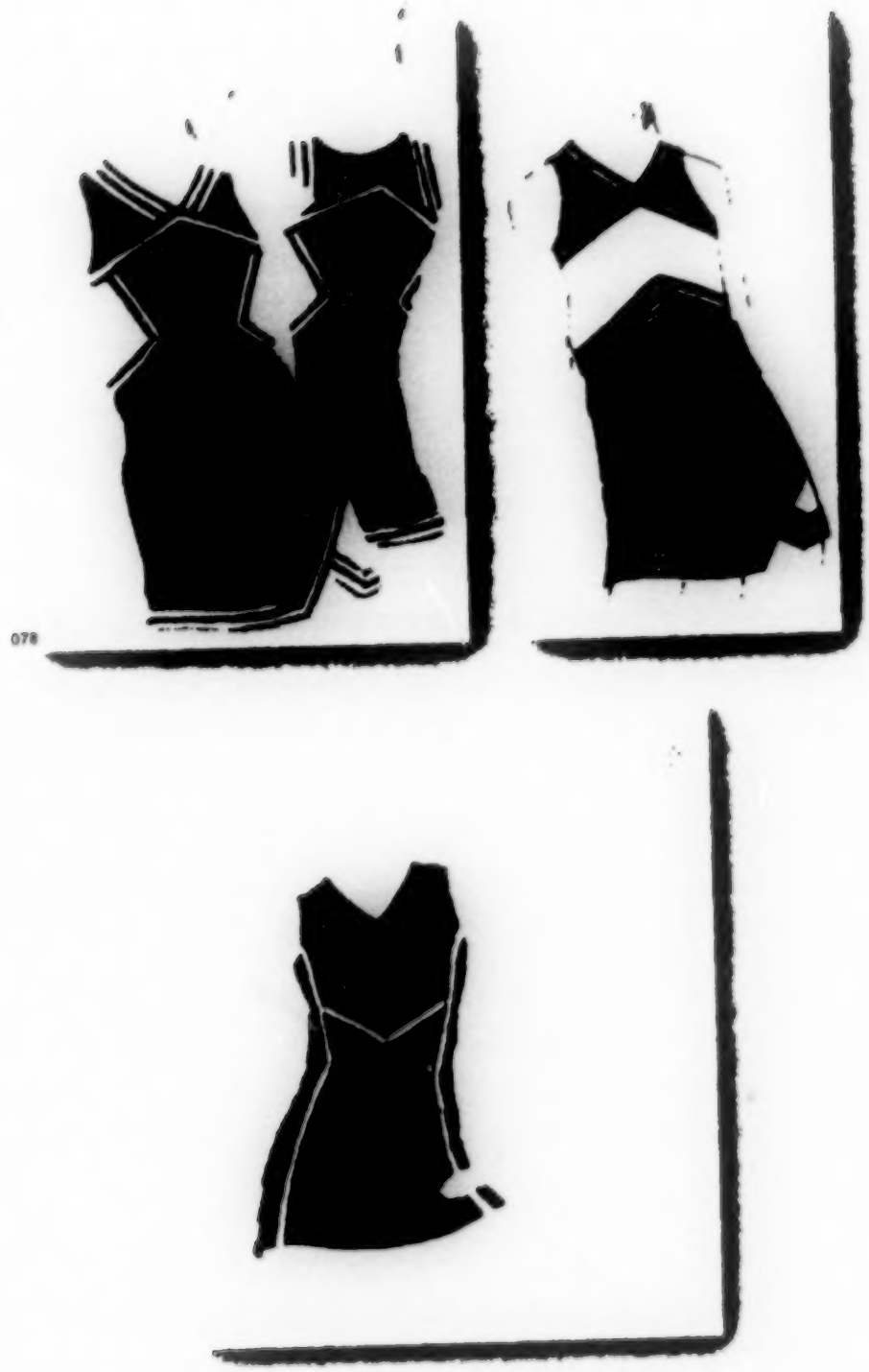
Section 102 of the Copyright Act, 17 U.S.C. § 102, states, in pertinent part:

> **(a)** Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> * * *
>
> **(5)** pictorial, graphic, and sculptural works

Sections 101 and 102 of the Copyright Act are set forth in their entirety in this brief's appendix.

COPYRIGHT DEPOSITS INVOLVED

J.A. 82-83.



J.A. 32, 70. 81.

INTRODUCTION

Respondents Varsity Brands, Inc., and its affiliates sued Petitioner Star Athletica, L.L.C., for allegedly copying Varsity's cheerleader uniforms. A useful article—such as a chair, a dress, or a uniform—cannot be copyrighted. The Court granted the petition to determine when a useful article's design *features* are sufficiently separate from the article to warrant copyright protection.

As the Copyright Office has explained, "the copyright law is reasonably clear. Garments are useful articles, and *the designs of such garments are generally outside of the copyright law.* Parties who wish to modify this position must address their concerns to the Congress." Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,532 (Nov. 5, 1991) (emphasis added). Numerous commercial interests have attempted to do exactly that. But Congress has persistently declined all requests to extend the copyright laws to garment design. The most recent attempt, in 2012, would have granted such protection, but for only three years.

Varsity now asks this Court to ordain by judicial edict what these commercial interests have been unable to obtain from Congress—except the copyright protection Varsity seeks will last not three years, but for a century. Such a ruling would be a boon to companies like Varsity, who already hold a monopoly on their garment-market segment. But it would be deleterious to the public, which depends on the Copyright Act's exclusion of industrial design to keep useful articles like garments in the public domain. The Court should reverse the court of appeals and reinstate judgment as a matter of law for petitioner Star Athletica.

STATEMENT OF THE CASE

The Copyright Act and "useful articles"

Congress's authority to grant copyrights originates in the Constitution which provides, "The Congress shall have the Power [t]o promote the Progress of Science and Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Const. Art. I, § 8, cl. 8. "[T]he primary object in conferring the [copyright] monopoly lie[s] in the general benefits derived by the public from the labor of authors." *Fox Film Corp.* v *Doyal*, 286 U.S. 123, 127 (1932).

Congress first exercised its constitutional power to enact copyright legislation in 1790 by protecting maps, charts, and books. Act of May 31, 1790, ch. 15, 1 Stat. 124. Congress extended protection to three-dimensional "fine arts" objects, such as statues and models, in 1870. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212. And though the 1909 Copyright Act removed the phrase "fine arts," Act of Mar. 4, 1909, ch. 320, 35 Stat. 1077, it was well understood that copyright did not protect garment design. *E.g.*, *Chosun Int'l, Inc.* v. *Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005) (citing *Fashion Originators Guild* v. *FTC*, 114 F.2d 80, 84 (2d Cir. 1940) (L. Hand, J.)).

Indeed, the garment-design industry was among the first to call for copyright protection of industrial designs, and a bill was introduced to do so in 1913. Statement of the Register of Copyrights, *Industrial Design Protection: Hearings on* H.R. 902, 3017, *and* 3499 *Before the Subcomm. on Courts, Intellectual Property & the Admin. of Justice of the H. Comm. on the Judiciary*, 101st Cong., 2d Sess., 436, 445–46 (1991) [hereinafter "1991 *Design Protection*

Hearings"]. But this bill, and many others intended to protect the design of useful articles, was never enacted. See *id.* at 445–50.

Then, in the mid-1950s, this Court considered a copyright-infringement claim involving the copyright of dancing figurines that formed the base for lamps and were also sold separately as statuettes. The Court made clear in *Mazer* v. *Stein*, 347 U.S. 201, 218–19 (1954), that a manufacturer cannot circumvent a work's copyright simply by using the work in a useful object. But the opinion said nothing about whether the lamp itself (or a coffee maker or wedding gown) could be copyrighted. So the Copyright Office issued a regulation that accommodated the Court's holding in *Mazer* while continuing to exclude industrial design—the separability standard:

> If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will *not* qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, *which can be identified separately and are capable of existing independently as a work of art*, such features will be eligible for registration. [37 C.F.R. § 202.10(c) (1959) (revoked after implementation of the 1976 Copyright Act) (emphasis added).]

The *Mazer* decision has been interpreted to stand for the proposition that copyright can be claimed in artistic features of a useful article that are capable of separate and independent existence apart from the shape of the useful article. 1991 *Design Protection Hearings* at 448.

In 1961, the Copyright Office reaffirmed that useful articles should not be copyrighted. H. Comm. on the Judiciary, 87th Cong., 1st Sess., Copyright Law Revision, Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law 13 (Comm. Print 1961). As the Office explained, copyright protection for industrial design is problematic given the anticompetitive fallout of providing long-term protection for commercial design and the staggering potential liability for distributors who innocently sell useful articles. *Ibid.*

The Copyright Office considered garments particularly ill-suited to copyright protection, and it opposed extending copyright protection to "wearing apparel." *Ibid.* A yard of dress material or a dress itself would not be accepted for deposit with the Copyright Office because they are useful articles. *Id.* at 14. Similarly, a copyright in a work that *displays* useful articles, like a sketch or photograph of a dress, would not protect against the manufacture of the dress itself. *Ibid.* See also, H. Comm. on the Judiciary, 89th Cong., 1st Sess., Copyright Law Revision, Supplementary Register's Report on the General Revision of the U.S. Copyright Law 47–48 (Comm. Print 1965).

Notwithstanding this advice, the Senate proposed, as part of the comprehensive revision of copyright law in 1976, design-protection legislation that, excluding "staple or commonplace" designs and those "dictated solely by a utilization function of the article," would protect the "original ornamental design of a useful article" for five years, 10 years if renewed. S. 22, Tit. II, 94th Cong., 1st Sess., §§ 201–35, 122 Cong. Rec. 3856–59 (1975), *reprinted in* S. Rep. No. 473, at 39–47 (1975); S. Rep. No. 473, 94th

Cong., 1st Sess., 161 (1975) (concluding that "[t]he term of copyright protection is too long for the majority of designs"). That proposal died in the House "because the new form of design protection could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision." H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659–5801. The House Report on the bill identified concern that such an extension of existing copyright law "would create a new monopoly which has not been justified by a showing that its benefits will outweigh the disadvantage of removing such designs from free public use." *Ibid.* The conference committee rejected the Senate's design-protection legislation. H.R. Rep. No. 94-1733 at 82 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5810. And the Copyright Office's administrative regulations were formally codified in § 101 of the Copyright Act of 1976. 17 U.S.C. § 101. For an even more comprehensive review of the history of the Act, see J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 Duke L.J. 1143 (1983).

The 1976 Act did not change the longstanding rule that clothes cannot be copyrighted. It remains well settled that garments are useful articles. *Whimsicality, Inc.* v. *Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989). See also Kal Raustiala, Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687, 1698 (2006). The Copyright Office agrees that "the designs of [ ] garments are generally outside of the copyright law." Registrability of Costume Designs, 56 Fed. Reg. at

56532. And the fashion industry has continued to lobby for design protection to no avail. See Statement of the Copyright Office, *Industrial Design Protection: Hearings on* H.R. 5055 *Before the Subcomm. on Courts, Intellectual Property & the Admin. of Justice of the H. Comm. on the Judiciary*, 109th Cong., 2d Sess. (2006).

As noted above, the Copyright Act does not extend copyright protection to the design of useful articles, defined as those articles "having an intrinsic utilitarian function that is not *merely* to portray the appearance of the article or to convey information." 17 U.S.C. § 101 (emphasis added). While a feature of the design of a useful article can sometimes be protected (think "The Spirit of Ecstasy" hood ornament on a Rolls-Royce), copyright normally extends only to those features capable of being "identified separately from, and . . . existing independently of, the utilitarian aspects of the article." *Ibid.*

Finding consensus on a test for separability has proven difficult. Courts "have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function." *Masquerade Novelty, Inc.* v. *Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990). The Sixth Circuit's decision here contributed to the confusion by adding a tenth separability test and reached an outcome at odds with a century of public policy against extending copyright protection to garment design. This case is the opportunity to clarify the appropriate test, to place garment design squarely in either the public domain or the design-patent regime, as Congress intended, and ensure that the stripes, chevrons, and

color blocks of a cheerleading-uniform design do not receive a century of copyright protection. (Depending on the nature of authorship, the duration of a copyright is usually the author's life plus 70 years, or 95 years from first publication or 120 years from creation, whichever is shorter. 17 U.S.C. § 302.)

The parties and cheerleading-uniform designs

Respondent Varsity is the world's largest manufacturer and distributor of cheerleading and dance-team uniforms and accessories, commanding 80% or more of the roughly $300 million cheerleading-apparel market. Leigh Buchanan, *Inside the Vicious, Vicious Cheerleader Wars*, Inc. (March 2016); *see* J.A. 16–17. As reported in *Fortune* magazine, "[n]early every uniform sold or camp attended by high school or college cheerleaders is part of Varsity's vast empire of pep." Colleen Leahey, *The business of cheer*, Fortune (Dec. 21, 2012).[1]

To build its empire, Varsity copied cheerleader-uniform designs from its competitors. J.A. 188. Each year, Varsity would select certain competitors' designs and add them to its product line. R.169, Ex. 43 Williams Dep. 190–91. And if a customer requested a competitor's style that was not already included in Varsity's product line, Varsity trained its sales staff to submit a request to Varsity to create a custom copy of the competitor's uniform. *Ibid.*

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[1] Available at http://goo.gl/EaECwa.

To protect its cheer empire, Varsity sues or threatens to sue new market entrants[2] or simply acquires its successful competitors.[3] The net result is inflated uniform prices, to the detriment of families everywhere. *E.g.*, Courtney Spradlin, *'Pay-to-play' cheerleading often cost prohibitive*, Shreveport Times (Feb. 20, 2015).[4]

Varsity employs designers whose task, at all times, is conceiving and sketching three-dimensional uniforms. Pet. App. 73a. Indeed, Varsity's designers conceive of their designs as worn by cheerleaders, *ibid.*, and begin their process by sketching a design over an outline of a cheerleader, Pet. App. 60a. Not surprisingly, each design produced by Varsity's designers is of a three-dimensional cheerleading uniform, not an abstract, two-dimensional artistic work. See *ibid.*, see, e.g., J.A. 324-338 (scads of other cheerleading-uniform designs registered by Varsity).

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[2] *E.g.*, *Varsity Brands, Inc.* v. *Teamleader.com*, No. 05-Civ.-2340 (W.D. Tenn. 2005) (copyright infringement); *Varsity Brands v. It's Greek to Me Inc.*, No. 11-cv-2465 (W.D. Tenn. 2005) (same); *Varsity Brands, Inc.* v. *J&M Spirit Wear, Inc.*, No. 09-cv-1795-PKC (S.D.N.Y. 2009) (same); *Varsity Brands v. YSS Athletics, Inc.*, No. 09-cv-2322 (S.D.N.Y. 2009) (same); *Varsity Brands, Inc.*, v. *Sills*, No. 1:2010cv01164 (W.D. Tenn. 2010) (same); *Varsity Brands, Inc.* v. *MSG Holdings, L.P.*, No. 1:2011cv08053 (S.D.N.Y. 2011) (trademark); *Varsity Spirit Corp.* v. *Cheer Etc.*, No. 1:2011cv08312 (S.D.N.Y 2011) (same). See also J.A. 171-174.

[3] http://goo.gl/okVUdJ (noting Varsity's November 2015 acquisition of JAM Brands).

[4] Available at http://goo.gl/JiD9KV

One of Varsity's designers, Joseph Long, described the design process for two of the cheerleading-uniform designs at issue in this litigation, designs 299A (shown below) and 299B. J.A. 82-83, 357.

Long explained that what he designed was "a high quality. functional cut-and-sew garment." J.A. 357 The cut-and-sew process for garment manufacture involves cutting fabric into various shapes and sewing the shapes together, incorporating braid trim pieces and other elements of the garment design. J.A. 361-363 (graphic representation of the cut-and-sew process).

Long intended to design "a customer-color-customizable cut-and-sew garment style" that facilitated "assigning school colors to each of the panels and for all the pieces of the seam-covering striped braid." J.A. 357 His design was intended to allow

customers to be a team and showcase their school spirit. *Ibid.* The design was not intended to be "fabric design artwork." *Ibid.*

Varsity has registered more than 200 drawings and photographs of three-dimensional uniforms with the Copyright Office. J.A. 244–246. When Varsity sought to obtain copyright protection for its designs, including designs 299A and 299B, it characterized the designs as fabric designs or two-dimensional artwork. J.A. 38, 46, 48, 57. But in each instance, the deposit material Varsity submitted to the Copyright Office consisted of either a sketch of a figure wearing a cheerleading uniform or a photograph of a three-dimensional cheerleading uniform. J.A. 32, 70, 81, 82, 83, 324–338. The pictures Varsity submitted with regard to the two designs at issue here, designs 299A (pictured above) and 299B, show ripples in the solid-colored fabric panels, and curvature of the striped braid at the edges forming chevrons. J.A. 82-83. The puckered fabric is necessary for the design to conform to the wearer's body.

The Copyright Office initially rejected many of Varsity's cheerleading-uniform designs. J.A. 148. The Copyright Office noted that Varsity was seeking to copyright clothing which are useful articles and cannot be copyrighted. *Ibid.* The Copyright Office explained that Varsity could seek patent protection for its industrial designs. J.A. 150. Varsity vociferously objected that it was not seeking to copyright clothing designs; Varsity claimed it was seeking to copyright only the design of stripes, chevrons, and color blocks appearing "on" the cheerleading uniforms. J.A. 131. The Copyright Office advisory attorney ultimately capitulated and registered the works as "articles of clothing." J.A. 66.

Contrary to Varsity's representations to the Copyright Office, Varsity's lead designer testified that stripes, chevrons, zigzags, and lines are all "basic elements" of cheerleading-uniform design. J.A. 294, 305. This conclusion is logical, as "[m]ost cheerleading designs use diagonals, curves, lines and bright colors *to achieve the function of identifying the person wearing it as a cheerleader*" and as a member of a particular team. R.169-2, Sarabia Decl. ¶¶ 10–11, Pg. ID 2180–81 (emphasis added).

These basic elements also provide an important function integral to the style lines of uniforms manufactured by the "cutting and sewing" method of manufacture, which is how Varsity made the uniforms at issue here and almost all of its other cheerleading uniforms. R.169, Ex. 43 Williams Dep. 187–188; R.182, Pls.' Opp. To Def.'s Objection to Varsity's Submission of Sublimated Materials 8, Pg. ID 3740 (designs at issue "were not in existence" in this case as sublimated material when fact discovery ended). Cheerleader uniforms are commonly stitched such that seams are on the *outside* for a clean inside surface, facilitating fit, comfort, and performance. Gary Spencer, a Varsity vice president, concedes that braid on Varsity's uniforms has a functional purpose of covering these outside seams. R.169-1, Ex. 44, Spencer Dep. 95:22–24.

After obtaining copyrights, Varsity advertised its designs in its catalog depicting cheerleading uniforms worn by young people. R,176, Def.'s Resp. to Varsity's Statement of Undisputed Facts, Exs. C, H-J (excerpts from Varsity's catalogs). Varsity's protestations to the Copyright Office notwithstanding, Varsity proclaimed "[e]very Varsity *uniform* is an original copyrighted design." J.A. 185 (emphasis

added). And its catalogs included a carefully crafted copyright notice that purported to protect Varsity's "uniform designs":

> Uniform Design © 2009 Varsity Spirit Corporation. All rights reserved. The original *uniform designs* depicted in this catalog are the exclusive property of Varsity Spirit Corporation. They may not be reproduced or manufactured without written permission from Varsity Spirit Corporation. [J.A. 181 (emphasis added).]

Believing that it has obtained a century of copyright protection for its cheerleading-uniform designs, Varsity uses its "Uniform Design" copyrights to prevent competitors from copying its cheerleading-uniform designs (even though Varsity did the same to obtain market share). J.A. 175–86. Consistent with its catalog copyright notices, Varsity threatens competitors with litigation for violating its purported copyrights in "certain garment designs." J.A. 171.

Star Athletica attempts to enter the cheerleading uniform market.

Created in 2010, Star Athletica, L.L.C., is a new entrant in the cheerleading-uniform market. See J.A. 190–91, 212. After Star published its first catalog, Varsity immediately sued. Pet. App. 59a. Varsity alleged that certain Star cheerleading uniforms infringed the copyrights Varsity possessed in five two-dimensional cheerleading-uniform drawings and photographs of cheerleading uniforms, J.A. 21–25, as if such copyrights could protect against the very thing Varsity told the Copyright Office it was not seeking—protection against the shape, contour, cut,

style, and fit of Star's cut-and-sew cheerleading-uniform designs.[5] See *id.* at 130–32.

District Court proceedings

To establish copyright infringement, Varsity must prove " '(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.' " Pet. App. 62a (quoting *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)). The district court resolved the case on summary judgment, focusing on the scope of protection afforded by Varsity's copyrights. Pet. App. 62a–75a. Consequently, Varsity's infringement arguments and Star's defenses have not been resolved.

The district court ruled that Varsity's copyrights in two-dimensional drawings and photographs of cheerleading uniforms could not be used to prohibit Star from manufacturing actual cheerleading uniforms. The district court framed the issue in the case as whether "a cheerleading uniform can be conceived without any ornamentation or design, yet retain its utilitarian function as a cheerleading uniform?" Pet. App. 72a–73a. The court answered that a cheerleading uniform without stripes, patterns, and chevrons, is *not* a cheerleading uniform.

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[5] Varsity's Complaint also included various state-law claims against Star. J.A. 25–28. The state-law claims were dismissed consistent with 28 U.S.C. § 1367(c)(3). Pet. App. 76a–77a. Star counterclaimed, alleging that Varsity committed fraud on the Copyright Office and violated federal antitrust laws. J.A. 120–22. The district court dismissed Star's antitrust counterclaims under Rule 12(b)(6), J.A. 170, and deemed the rest of Star's counterclaims to be (yet-to-be-resolved) affirmative defenses, Pet. App. 75a n.5.

The court explained, "it is not possible to either physically or conceptually sever Varsity's designs from the utilitarian function of the resulting cheerleading uniforms ." Pet. App. 75a. The function of a cheerleading uniform "is not merely to clothe the body; it is to clothe the body in a way that evokes the concept of cheerleading." Pet. App. 74a. The court explained that "a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas. [A] blank silhouette of a purported 'cheerleading uniform' without team colors, stripes, chevrons, and similar designs . . . is not recognizable as a cheerleading uniform." Pet. App. at 73a–74a; see also J.A. 271–72 (blank silhouettes).

The district court also rejected Varsity's contention that its cheerleading designs were conceived of independent of their function as cheerleading uniforms. The court noted that "[t]he design sketches are clearly of cheerleading uniforms, conceived as worn by cheerleaders. It also appears to be true that the designers were at all times conceiving of and sketching various designs of cheerleading uniforms." Pet. App. 73a. This is no surprise, as Varsity's designers were employed to create designs for a cheerleading-uniform manufacturer. See J.A. 17.

Sixth Circuit proceedings

On appeal, the panel majority began by considering the level of deference to give to Varsity's copyright registration. The court gave *Skidmore* deference to the Copyright Office's registration decision, but the panel majority failed to consider, much less defer to, the Copyright Office's reasoned policy that garments are not protectable. See Pet.

App. 19a, 37a–40a. And it rejected altogether the Copyright Office's test for analyzing separability. Pet. App. 30a, 37a–38a.

The panel majority identified nine other separability tests, most of which had been adopted by other circuits. Pet. App. 30a–33a, The court rejected all of these tests in favor of "[t]he Sixth Circuit Approach." Pet. App. 37a–38a.

The panel majority next adopted Varsity's narrow view of a cheerleading uniform's function: to "cover the body, wick away moisture, and withstand the rigors of athletic movements." Pet. App. 43a. The panel majority side-stepped the argument that stripes, chevrons, and the like (1) identify the wearer as a member of a cheerleading team, (2) are part of the overall shape, contour, cut, style, and fit of cheerleading uniforms, and (3) enhance structural stability and the attractiveness of the wearer. Pet. App. 43a–44a. The panel majority concluded that stripes, chevrons, and color blocks served *no* utilitarian function but rather only a decorative function, opening the door for Varsity to use its copyright in two-dimensional sketches and photographs to stop Star from making actual, three-dimensional cut-and-sew cheerleading uniforms. Pet. App. 45a–46a.

In dissent, Judge McKeague observed that stripes and chevrons serve the important function of "identify[ing] the wearer as a cheerleader." Pet. App. 53a. A plain white uniform "may be appropriate for a match at the All England Lawn Tennis Club, but not for a member of a cheerleading squad." *Ibid.* Judge McKeague cited the only two circuit decisions addressing separability in the context of garment design—the Second Circuit's decision in *Jovani Fashion, Ltd.* v. *Fiesta Fashions*, 500 F. App'x 42 (2d

Cir. 2012), holding that a designer cannot claim copyright in the arrangement of decorative sequins, crystals, ruche, and tulle on a prom dress, and the Fifth Circuit's decision in *Galiano* v. *Harrah's Operating Co.*, 416 F.3d 411 (5th Cir. 2005), holding that a designer cannot claim copyright in a casino uniform's stripes, color blocks, and star-shaped buttons. And Judge McKeague rejected the panel majority's approach to utilitarian function: a "uniform at its core identifies its wearer as a member of a group. [T]he stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function." Pet. App. 54a.

Judge McKeague also rejected the claim that such a conclusion would "render nearly all artwork unprotectable." Artwork is not a "useful article" under § 101 and thus is protected. *Ibid.* And after the majority's willingness to recognize copyright protection for items with utilitarian function, companies like Varsity are allowed "the protection of patent-like features without having to fulfill the rigorous standards for obtaining a design patent." Pet. App. 56a (quoting *Winfield Collection, Ltd.* v. *Gemmy Indus., Corp.*, 147 F. App'x 547, 550–52 (6th Cir. 2005)).

The Sixth Circuit denied rehearing en banc but stayed its order pending resolution by this Court.

SUMMARY OF THE ARGUMENT

In the Copyright Act of 1976, Congress did not intend to grant a century of monopoly protection to cheerleader-uniform designs—or any garment designs for that matter. Quite the opposite, Congress first proposed and then deliberately excluded industrial-design protection in the Act, and it has declined every invitation to extend copyright protection to garment design, even for a period as short as three years.

When determining whether a design feature of a useful article like a garment can be copyrighted, courts must apply the separability analysis set forth in § 101 of the Copyright Act. At its most basic, that framework requires a court to identify all of the article's inherent, essential, or natural functions, then determine whether a design feature (1) can be recognized as a unit by itself, apart from the article's utilitarian aspects (the identified-separately requirement), and (2) can exist side by side with the useful article with both perceived as fully realized, separate works (the exist-independently requirement).

In a close case, a court should decline to provide copyright protection to a useful article's design features. This is consistent with Congress's choice not to extend the copyright monopoly to industrial design and protects the public interest.

But this is not a close case. The features of a cheerleader uniform do not satisfy the identified-separately requirement or the exist-independently requirement. Unsurprisingly, faithful application of the statutory test demonstrates that Varsity does not have a century-long copyright monopoly that prevents Star Athletica from competing in the cheerleader-uniform market.

ARGUMENT

I. The Court should adopt an analytical framework for separability based on § 101's statutory text.

As noted in the petition, there are at least ten unique tests for separability. Pet. 21–23 & n.8. While each of these tests has been commended and criticized, none of them construes § 101 of the Copyright Act the way this Court typically interprets statutes: by parsing the statute's words "in their context, and with a view to their place in the overall statutory scheme," *Davis* v. *Michigan Dept. of Treasury*, 489 U.S. 803, 809 (1989), and, "[w]henever possible, in accordance with constitutional principles," *American Power & Light Co.* v. *Sec. & Exch. Comm'n*, 329 U.S. 90, 108 (1946). Accordingly, Star Athletica begins with the constitutional framework for copyright protection and Congress's implementation of that framework.

A. The Copyright Act of 1976 implements the Copyright Clause's purpose of encouraging the development of artistic works.

The Copyright Clause, Article 1, § 8, cl. 8, empowers Congress "To promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The Clause's purpose is not to protect the pecuniary interest of inventors and authors, or to ensure their compensation, but to encourage the development of scientific progress and artistic work. *E.g.*, *Sony Corp. of Am.* v. *Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984); *United States* v. *Paramount Pictures, Inc.*,

334 U.S. 131, 158 (1948) (quoting *Fox Film Corp.* v. *Doyal*, 286 U.S. 123, 127 (1932)). "As a result, courts . . . must occasionally subordinate the copyright holder's interest in a maximum financial return to the greater public interest in the development of art, science, and industry." *Berlin* v. *E.C. Publ'ns, Inc.*, 329 F.2d 541, 544 (2d Cir. 1964). The Copyright Act of 1976 advances the constitutional purpose of offering a limited copyright monopoly in exchange for more innovation.

In so doing, Congress continued the longstanding rule that useful articles cannot be copyrighted. 17 U.S.C. §§ 101, 102. As noted above, Congress rejected efforts to extend copyright to the "original ornamental design of a useful article" for a maximum of 10 years because this "new form of design protection . . could not truly be considered copyright protection." H.R. Rep. No. 94-1476 at 50 (1976).

The rule against granting copyright monopolies to designers of useful articles demonstrates Congress's reasoned judgment as to the appropriate balance between the need to stimulate creativity and the deleterious effects of monopolies. See *Sony*, 465 U.S. at 429 & n.10 (quoting H.R. Rep. No. 2222, 60th Cong., 2d Sess. 7 (1909)). Congress has channeled intellectual-property protection for useful articles into regimes that it believes more appropriately balance the public's interest in competition and promoting the advancement of the Arts and Sciences, such as design patents, trademarks, and specific regimes for particular kinds of articles. Cf. *Am. Dental Ass'n* v. *Delta Dental Plans Ass'n*, 126 F.3d 977, 980 (7th Cir. 1997) (characterizing separability analysis as establishing the line between copyright and other bodies of intellectual-property law). This

Court has identified that the "dichotomy of protection" for aesthetic features "is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents." *Mazer* v. *Stein*, 347 U.S. 201, 218 (1954).

Like copyright, the patent regime originates from the Patent and Copyright Clause and is thus designed to incentivize the production of novel inventions and, within a relatively short period, move those inventions into the public domain. *Kewanee* v. *Bicron*, 416 U.S. 470, 480 (1974). Design patents apply to "new, original, and ornamental design[s]" for articles of manufacture. 35 U.S.C. § 171. Among the important differences between copyrights and design patents, design patents are only available for novel, non-obvious designs that cannot be anticipated from prior art. See *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 149-50 (1989). Applications for design patents are given greater scrutiny than copyright registrations. *Carol Barnhart Inc.* v. *Econ. Cover Corp.*, 594 F. Supp. 364, 367 (E.D.N.Y. 1984). And design patents last 15 years, 35 U.S.C. § 173, not a century. As this Court explained, "the efficient operation of the federal patent system depends upon substantially free trade in publicly known, unpatented design and utilitarian conceptions." *Bonito Boats*, 489 U.S. at 156. Although overlap between copyright and design patents may be inevitable, *Application of Yardley*, 493 F.2d 1389, 1394 (C.C.P.A. 1974), liberally granting copyright to utilitarian articles undermines the patent system. (Trademark, while another important area of intellectual-property protection, does not have a constitutional foundation.)

The Copyright Act's plain text must therefore be construed in the context of the overarching constitutional policy that animates the exclusion of the designs of useful articles, as well as Congress's repeated refusal to expand protection of industrial design of useful articles including garments.

B. The statutory basis for separability

With this background, we turn to the text of the Copyright Act. In § 102, Congress provides that "[c]opyright protection subsists . . in original works of authorship" including "pictorial, graphic, and sculptural works." 17 U.S.C. § 102(a)(5).

Section 101 defines "pictorial, graphic, and sculptural works":

> two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; *the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.* [17 U.S.C. § 101 (emphasis added).]

Thus, copyright protection for pictorial, graphic, and sculptural works broadly covers all aspects of fine art, applied art, photographs, and the like, and

extends to the form but not the function of works of artistic craftsmanship. But the designs of useful articles are pictorial, graphic, or sculptural works—and thus protected by copyright—*only* if the designs meet the statutory test for separability.

The § 101 text addressing separability has three parts, and the third part has two sub-parts.

1. Section 101's definition of pictorial, graphic, and sculptural works creates a presumption *against* copyright protection for the design of any useful article or feature of a useful article: copyright protection in any design of a useful article exists "if, *and only to the extent that*, such design incorporates pictorial, graphic, or sculptural features" that are separable. 17 U.S.C. § 101 (emphasis added). Thus, no matter how creative and artistic a feature of the design of a useful article, it is not protectable unless it is separable from the useful article itself. See Compendium of U.S. Copyright Office Practices § 924.2 (3d. ed. 2014) [hereinafter "Compendium III"] ("Congress has made it clear that the Copyright Act does not cover any aspect of a useful article that cannot be separated from its functional elements."). And § 101 reiterates that a work's "utilitarian aspects" are never protected by copyright. 17 U.S.C. § 101. In other words, the Copyright Act intentionally under-protects creative and artistic features of the designs of useful articles.

The presumption against protecting the designs of useful articles is confirmed by Congress's actions before, during, and after the adoption of the Copyright Act. In the 1950s, the Register of Copyrights and some in the Congress sought to adopt a new regime to protect industrial designs for a period of

five years that would operate side-by-side with design-patent law and existing copyright law. See Reichman, *Design Protection*, 1983 Duke L.J. at 1186-95 (discussing S. 2075, 86th Cong., 1st Sess. May 28, 1959). The attempt to adopt so-called *sui generis* protection for industrial design ultimately culminated in Title II to the revision of the Copyright Act that was adopted by the Senate, but stricken by the House. See *id.* at 1251-62. Between 1914 and 1978, Congress rejected approximately 70 design-protection bills. See *Esquire, Inc.* v. *Ringer*, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978).

In the House Report accompanying the revised Copyright Act, the Judiciary Committee noted that it "added language to the definition of 'pictorial, graphic, and sculptural works' in an effort to make clearer the distinction between works of applied art protectable under the bill *and industrial design not subject to copyright protection.*"[6] H.R. Rep. No. 94-1476, at 50 (emphasis added). The language was intended to "draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design." *Id.* at 55. The Copyright Office has relied on this language to support its policy of generally refusing to register garment designs including uniforms. Registrability of Costume Designs, 56 Fed. Reg. at 56,530-31.

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[6] Industrial design is " '[t]he professional service of creating and developing concepts and specifications that optimize the function, value, and appearance of products and systems for the mutual benefit of the user and the manufacturer' " Cooper C. Woodring, *A Designer's View on the Scope of Intellectual Property Protection*, 24 AIPLA Q.J. 309, 309 (1996) (quoting the Industrial Designers Society of America's definition).

Since the adoption of the Copyright Act, Congress has adopted two forms of *sui generis* protections for industrial designs. In 1984, Congress adopted a new type of intellectual property protection for the layout of semiconductor chips. 17 U.S.C. §§ 901–14. In 1998, it enacted the Vessel Hull Design Protection Act, providing a new type of protection for boat hulls. 17 U.S.C. §§ 1301–32 Semiconductor chip layouts and boat hulls are protected for just ten years. 17 U.S.C. §§ 904, 1305. Despite repeated attempts by various commercial interests, Congress has not adopted any other new forms of intellectual property protection for industrial designs.

Thus, in the language of § 101 and its course of conduct before, during, and after the passage of the Copyright Act of 1976, Congress demonstrated that copyright protection is not available for articles of industrial design. And given the explicit grant of constitutional authority, courts are properly reluctant "to expand the protections afforded by the copyright without explicit legislative guidance." *Sony*, 464 U.S. at 431.

2. Section 101 defines a "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101 ("useful article" definition). "An article that is normally a part of a useful article is considered a 'useful article'." *Ibid.* A function is "intrinsic" if it is part of the article's natural, essential, or inherent nature. *Shorter Oxford English Dictionary* 1420 (6th ed. 1993) [hereinafter "*Shorter OED*"]. Thus, if an article has a useful function that is inherent, essential, or natural to what the article is, then it is a useful

article. The uses for which an article is marketed are strong evidence of its functions.

Congress recognized that works of fine art and other pictorial, graphic, or sculptural works might be said to have a utilitarian function of portraying the article itself, like a painting or sculpture, or conveying information, like a map or diagram. 17 U.S.C. § 101. To the extent that an article serves to portray its own appearance or convey information, *and nothing more*, it is protectable.

Congress also explained that "[a]n article that is normally a part of a useful article is considered a 'useful article'." *Ibid.* This is true regardless of whether the feature is otherwise separable from the design of the useful article. For example, wheel covers are normally part of an automobile, and both automobiles and wheel covers are useful articles. See *Norris Indus., Inc.* v. *Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983). This non-protection for parts of a useful article furthers Congress's interest in funneling protection for industrial design into design patents or an as-yet-unadopted *sui generis* protection.

3. Section 101 describes the features of a useful article that a claimant *can* copyright: "features that [1] can be identified separately from, and [2] are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101. The phrases "that can be identified separately from" and "are capable of existing independently of" both modify the final phrase, "the utilitarian aspects of the article." The "and" that connects the two phrases means both must be satisfied for a work to be copyright-eligible. So the feature must be able to be identified sepa-

rately from the utilitarian aspects of the pictorial, graphic, or sculptural article, *and* the feature must be capable of existing independently of the utilitarian aspects of the pictorial, graphic, or sculptural article. The purpose of this inquiry is to help determine whether an article's feature is artistic, utilitarian, or both. If the feature is solely artistic, it can be copyrighted. If the feature is even slightly utilitarian or both utilitarian and artistic, it cannot be copyrighted.

3.a. Begin with the first of these two parts—a "feature[ ] that can be identified separately from . the utilitarian aspects of the article." "Identify" means to "establish" or "recognize" what something is. *Shorter OED* at 1319; *Random House Webster's Unabridged Dictionary*, 1746 (2d ed. 2001). "Separate" means "[e]xisting or regarded as a unit by itself." *Shorter OED* at 2756. So a feature of a useful article must be recognizable as a unit by itself, apart from the article's utilitarian aspects.

For example, the identified-separately requirement could not be satisfied by the fanciful bike rack in *Brandir Int'l Inc.* v. *Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987). There, a sculptor adapted one of his sculptures to accommodate the utilitarian function of holding up bicycles, "a product of industrial design." *Id.* at 1147. (The copyright was asserted in the bike rack, not the sculpture.) In so doing, there was no artistic element of the bike rack that could be "identified as separate" from "the utilitarian aspects of the article." *Id.* at 1148. The artistic shape of the rack simultaneously served a utilitarian purpose. Accordingly, it could not be copyrighted.

The same would be true with those parts of the shape of a container necessary to hold the liquid within it. *E.g.*, *Ets-Hokin* v. *Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (analyzing a vodka bottle). No matter how artistic or original, the container's shape is merged with the container's utilitarian function of retaining the liquid within it insofar as the shape accomplishes that function, and the container cannot be identified separately. See *Inhale, Inc.* v. *Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1042 (9th Cir. 2014) (analyzing a hookah water container).

Or consider "the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching at the dress waist; and layers of tulle on the skirt" of a prom dress. See *Jovani Fashion, Ltd.* v. *Fiesta Fashions*, 500 F. App'x 42 (2d Cir. 2012). In addition to assisting with covering the body, these features cause an observer to perceive that the wearer is attending the prom, draw attention to certain parts of the wearer's body and not others, and generally create a slimming effect. In other words, the features are both artistic and utilitarian. That is why someone buying a prom dress asks "How does this dress make me look?" So the features cannot be "identified separately" from the dress. *Id.* at 45.

Admittedly, applying this identified-separately factor will not be determinative in many cases. It is often easy to separately identify features from the utilitarian aspects of useful articles, such as the three-dimensional carvings of shells, leaves, columns and rosettes decorating furniture. *E.g.*, *Universal Furniture Int'l, Inc.* v. *Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010). The analysis would then move to the independent-existence portion of

the inquiry. But applying the identified-separately filter honors the statutory text and will relieve courts in some cases from the need to engage in the more challenging independent-existence portion of the analysis.

3.b. The second of the two parts is a "feature[ ] . . . capable of existing independently of [ ] the utilitarian aspects of the article." "Exist" means to maintain objective reality or being. *Shorter OED* 894 (6th ed. 1993). "Independent" means not "dependent or contingent on something else for its existence." *Id.* at 1362. As the Copyright Office explains in the current edition of its Compendium of U.S. Copyright Office Practices, this requires that "the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article." Compendium III § 924.2(B). So on the one hand, the feature cannot advance the utility of the article, and the article cannot depend on the feature for its utility. On the other hand, the article cannot advance the aesthetics of the feature, and the feature cannot depend on the article for its aesthetics. Again, the purpose of this analysis is to determine whether a feature is solely artistic, only utilitarian, or both. Only the first kind of feature is protectable.

Star Athletica submits that there are three distinct approaches that courts and the Copyright Office have properly used that assist the exists-independently analysis. None of these approaches require a direct metaphysical contemplation of whether the feature is an artistic work.

Physical Separability

The first approach is to consider whether the feature "could be physically removed without altering the useful aspects of the article." Compendium III § 924.2(A). By definition, such a feature would be copyrightable because the feature is solely artistic, can be identified separately, and is capable of existing independently. A hood ornament is physically separable and thus protectable. *Ibid.*

Design Process

The second approach to assist in determining whether a feature is solely artistic, only utilitarian, or both, considers "whether the design elements can be identified as reflecting the designer's artistic judgment exercised *independently of functional influence.*" *Pivot Point Int'l* v. *Charlene Prods., Inc.*, 372 F.3d 913, 931 (7th Cir. 2004) (quoting *Brandir*, 834 F.2d at 1145) (emphasis added). This factor can be analyzed in a straightforward manner using two statutory criteria, utility and independence:

Was the feature created to produce a useful article? This criterion looks at the objective evidence of the creative environment. For example, at one end of the spectrum is a designer, employed by a car company to design a car part. It is highly likely the designer is making a utilitarian feature (or at least a utilitarian and artistic feature) rather than a solely artistic feature. At the other is a designer commissioned to sculpt a public monument. Everything about the article and its features is likely to be artistic. An industrial environment makes it more likely that function played a significant role in the design than a purely artistic environment.

How independent was the creative process? This criterion examines the objective evidence of the constraints imposed on the designer. For example, was the designer given an outline within which to create a design? This suggests a utilitarian feature. Or was the designer free to create without limitations of shape or form? This suggests an artistic feature. Is the feature part of the article's overall configuration? Does the feature hew so closely to the useful article's shape that it must be altered if the useful article's size changes? If so, the feature is utilitarian as well as artistic. The more the constraints, the more likely that function influenced design and the feature is therefore not protectable.

When a feature is designed to make a useful article and is the result of utilitarian pressures rather than artistic independence, the feature is nearly always incapable of existing independently. *Brandir*, 834 F.2d at 1147. This framework can often resolve the separability analysis.

Marketability

A third way to evaluate the exists-independently requirement is to ask if "there is substantial likelihood that" the pictorial, graphic, or sculptural feature "would still be marketable to some *significant* segment of the community" without its utilitarian function. *Galiano* v. *Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 *Nimmer on Copyright* § 2.08[B][3]) (emphasis added). In other words, without utilitarian function, does the feature still have significant market appeal "simply because of its aesthetic qualities"? *Ibid.* (quoting 1 *Nimmer on Copyright* § 208[B][3]). This analysis indirectly measures whether the feature is a "work[ ]

of fine, graphic, [or] applied art," 17 U.S.C. § 101, albeit by relying on the market and not a judge's personal views. Cf. *Bleistein* v. *Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) (calling it a "dangerous undertaking for persons trained only to the law to constitute themselves final judges" of artistic value). Without ever being incorporated into a lamp, the statuette in *Mazer* could be—and was—marketed to a substantial segment of the community as a statuette. *Mazer*, 347 U.S. at 203.

Even when applying these three approaches, the exists-independently evaluation will sometimes result in a close case. This is the consequence of the limited statutory guidance and the difficulty of determining separability. In such a case, a court should apply the background policy against extending a century of copyright monopoly protection to industrial design.

Consider a few examples. First, the stripes, color blocks, and star-shaped buttons incorporated in casino-uniform designs in *Galiano* do not satisfy the exists-independently requirement. As a threshold matter, no one contended these features were physically separable from the uniforms. More important, the features were designed specifically for the purpose of adorning casino uniforms and were designed to the cut and shape of the uniform. See *Galiano*, 416 F.3d at 413. The features were not created as standalone art pieces that were later appended to a garment. Finally, the features had utilitarian functions. They drew attention to the wearer and identified the wearer as a casino employee. That objective evidence, on its own, is enough for a court to conclude that the features do

not exist independently of the utilitarian aspects of the useful article and thus are not separable.

In addition, there is no substantial likelihood that the stripes, color blocks, and star-shaped buttons would be marketable to a significant segment of the community without their utility as casino-uniform ornamentation. Someone, somewhere, at some time, might, theoretically, purchase these features as art to hang on the wall, but a "significant segment" of the community would not. *Id.* at 422.

The mannequin heads in *Pivot Point* provide a more difficult case. There, the objective evidence showed that a German artist (Horst Heerlein) created an original sculpture of a female human head. He was told the head would be used by hair stylists and was given no specific dimensional requirements but was told to imitate the hungry look of high-fashion runway models. 372 F.3d at 931–32. Even if the sculpture's facial design features had no utilitarian use for hair stylists, it is not clear if they might still be marketed to a substantial segment of the community as art. And the two judges in the majority, the judge in dissent, and Judge Easterbrook (sitting as the district-court judge) differed sharply as to whether the mannequin head could serve its useful function without the features, or whether the features retained their aesthetics without being appended to the head itself. It would have been appropriate to apply the underlying copyright policy against protecting industrial design and deny copyright protection. But, what should have been dispositive was the fact that the features of the mannequin heads—no matter how artistic—served the utilitarian function of allowing a hair-stylist to practice his or her craft.

C. The statutory-separability analysis

Putting all the pieces together, separability under § 101 should be analyzed using the following framework:

1. A court begins the separability analysis by deciding whether the pictorial, graphic, or sculptural work is a design of a useful article. Designs of useful articles are presumptively not entitled to copyright protection. A feature of a useful article is protectable only if that feature satisfies the separability test, with doubts resolved against copyrightability.

2. The presumption against extending copyright protection to utilitarian objects requires courts to identify *all* of the article's inherent, essential, or natural functions. The uses for which an article is marketed is strong evidence of its functions.

3. Next, the court considers whether a feature of a useful article can be recognized as a unit by itself, apart from the article's utilitarian aspects (the identified-separately requirement) because it is purely artistic. If the answer is no, the feature cannot be copyrighted. Period.

4. Finally, the court considers whether the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article (the exist-independently requirement). So on the one hand, the feature cannot advance the utility of the article, and the article cannot depend on the feature for its utility. On the other hand, the article cannot advance the aesthetics of the feature, and the feature cannot depend on the article for its aesthetics. To assist in this analysis, a court should consider physical separability (which, if met, is dis-

positive), design process (which can be dispositive), and marketability (which can also be dispositive). Again, copyrightability turns on whether the feature is purely artistic. If the feature is even slightly utilitarian, it cannot be copyrighted.

In a close case, a court should follow its analogous approach in the trade-dress arena and decline to provide copyright protection to the useful article's design features based on Congress's choice not to extend the copyright monopoly to industrial designs. *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 529 U.S. 205, 215 (2000) ("To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning."). Any extra-legislative overextension of intellectual-property protection will naturally result in strike litigation that diminishes competition, see *id.* at 214–15, like this very suit.

II. Response to potential criticisms of Star Athletica's approach

Given that the federal courts have wrestled with § 101 separability for 40 years without coming to any notable consensus, Star Athletica's proposed statutory separability analysis undoubtedly would create "a sub-optimal prophylactic rule," *Galiano*, 416 F.3d at 421. The result at times may be that features one would expect are copyrightable are not. But this is the effect of Congress's stringent requirement for the separateness of any useful article's features. Nonetheless, there are several fair objections to various aspects of the statutory separability analysis Star proposes.

One possible objection to Star's approach is its consideration of whether design features can be identified as reflecting the designer's artistic judgment exercised independently of functional influence. Judge Kanne, in his *Pivot Point* dissent, criticized such an analysis because the "statute looks to the useful article as it exists, not to how it was created." 372 F.3d at 934.

But as the *Pivot Point* majority points out, the courts have reached common ground that the useful-article language in the Copyright Act's definition of a pictorial, graphic, or sculptural work "was intended to distinguish creative works that enjoy protection from elements of industrial design that do not." *Id.* at 920-21. Professor Denicola explained in *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983) (and the Second Circuit has agreed), that § 101's language draws "a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear." 67 MINN. L. REV. at 742, quoted in *Brandir*, 834 F.2d at 1145. That statutory limit is "an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist." *Ibid.* Industrial design is dominated "by the merger of aesthetic and utilitarian concerns." *Id.* at 739. The influence of nonaesthetic factors, and the dual requirements of what the product must do and how it must look that distinguishes the task of the industrial designer from that of a sculptor. *Id.* at 739-40. Thus, copyrightability "*should* turn on the relationship between the proffered work and the process of industrial design." *Id.* at 741 (emphasis added).

Professor Denicola articulates a test that is admirably consistent with § 101's text and purpose. But one might still object that the test creates an anomaly: two identical useful articles could have been created by two separate designers working autonomously, one in slavish adherence to the useful article's form and function, the other completely independent of such considerations. The result would be a complete bar to copyrightability for designer one, while leaving the door open to copyrightability for designer two. But this objection proves too much, because *every* design, theoretically, could be the product of chance. (Rather than one million monkeys typing randomly until accidentally writing Shakespeare's *Macbeth*, think of those same million monkeys making random drawings on blank pieces of paper until accidentally drawing a cheerleading-uniform design.) In real life, when a design is driven by the objective to make a useful article, is intertwined with the form or function of the useful article, and is the result of utilitarian pressures, the feature is the product of industrial design. And because Congress in the 1976 Act was specifically attempting to exclude industrial design from copyright protection, objective evidence of a process driven by the concerns of manufacturing a useful article should militate against copyrightability.

A second possible objection to Star's approach is consideration of marketability. In *Carol Barnhart, Inc.* v. *Economy Cover Corp.*, Judge Newman said that a marketability test privileges a judge's personal taste in popular art, requires conjecture, and is often undermined by the fact that the defendant in a copyright action has already copied the work at issue. 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting). These are fair criticisms.

But marketability can provide objective information regarding how a reasonable person would perceive a useful article's design features. This is why Star Athletica advocates *Nimmer*'s approach as a consideration in the exists-independently inquiry.

A third possible objection is Star's rebuff of other possible tests. But the remaining tests are fraught with problems. The primary-subsidiary approach requires a court to determine if a design's artistic features are "primary" to the "subsidiary utilitarian function." See *Kieselstein-Cord* v. *Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980). This test is hopelessly vague, difficult to apply, and turns almost entirely on a court's subjective determination of what aspects of a useful article are primary versus subsidiary. The ordinary-observer approach, which requires a court to ask whether an article "creates in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously," see *Carol Barnhart, Inc.*, 773 F.2d at 422 (Newman, J., dissenting), suffers from the same infirmities and the additional challenge of engaging in counterfactual metaphysics.

Other approaches the Sixth Circuit identified in its opinion, Pet. App. 30a–33a, also suffer from infirmities. For example, the objectively-necessary approach, see *Carol Barnhart Inc.*, 773 F.2d at 419, asks whether the feature is necessary to the useful article's function. This test is less restrictive than the statutory test, which excludes protection for any feature that has any utilitarian function. The stand-alone approach, see *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting), asks whether the useful article's functionality remains intact once the copyrightable material is separated. This, too, is less

restrictive than the statutory test, and for the same reasons.

Star's test subsumes Patry's approach, see 2 William F. Patry, *Patry on Copyright* § 3:145–46 (2015), which asks "whether the pictorial, graphic, or sculptural features are dictated by the form or function of the utilitarian aspects of the useful article," *id.* § 3:146. This test tracks a portion of Star's design-process approach but ignores other aspects of the test that the statutory text requires be included (such as the identified-separately requirement).

And the subjective-objective approach, referenced by the Sixth Circuit panel majority, see Pet. App. 33a, introduces the designer's subjective intent. Such a test could easily be gamed by a dishonest designer's testimony as to what "motivated" the design process.

A final objection might be to Star Athletica's suggestion that in a close case, a court should decline to provide copyright protection to the useful article's design features. But this analysis is grounded firmly in the Copyright Clause's underlying purpose, the Copyright Act of 1976's presumption against the copyrightability of useful articles and their design features, and Congress's persistent refusal to extend copyright protection not only to garment design, but the design of *any* useful article aside from boat hulls. (Notably, Congress enacted protection for boat-hull designs in 1998, nine years after this Court said federal patent law preempted protection for boat hulls under state law. But even then, Congress granted protection for only 10 years, not a century.)

Admittedly, no one, including Star or Varsity, can point to a single approach as flowing ineluctably from the statutory text. But this Court's instruction to lower courts to be cautious in recognizing separable features of useful articles will ensure that the public's right to copy and sell such articles is protected over the monopolist. *Cf. Bonito Boats*, 489 U.S. at 156; *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 229–31 (1964). In the Copyright Office's words, if Varsity wants greater protection for its garment designs, the way to do it is not through the court system. Varsity "must address [its] concerns to the Congress, since establishment of such protection must have Congressional authorization." Registrability of Costume Designs, 56 Fed. Reg. at 56,532.

III. Applying the § 101 separability test compels the conclusion that the features of a cheerleader uniform (stripes, chevrons, color blocks, braids) cannot be copyrighted.

It is undisputed that a garment is a useful article. Accordingly, a design of a cheerleading uniform, which is a type of garment, standing alone, is not copyrightable. It is indisputable that cheerleading uniforms normally include decorative features including color blocks and stripes. See J.A. 32–37, 324–38; R.176, Def.'s Resp. to Varsity's Statement of Undisputed Facts, Exs. C, H-J Excerpts from Varsity's catalogs (none of the cheerleading uniforms shown in Varsity's catalogs are monochrome). Thus, the arrangement of color blocks and stripes is also a useful article. 17 U.S.C. § 101. The presumption against copyright for garment design extends to any feature normally incorporated into the garment—such as the stripes, chevrons, or zigzags at issue

here—unless a particular feature can satisfy the separability analysis, i.e., the feature is solely artistic. Even the slightest utilitarian function results in no copyright for the feature.

To begin, a cheerleader uniform has a number of inherently useful functions. As the Sixth Circuit panel majority noted, a uniform must cover the body, wick away moisture, and withstand the rigors of athletic movement. Pet. App. 43a. A cheerleader uniform allows a third-party to perceive that the wearer is a cheerleader and is also a member of a particular cheerleading team. R.169-2, Sarabia Decl. ¶¶ 9–11, Pg. ID 2178–80. As Judge McKeague recognized in dissent (echoing the district court), an unadorned cheerleader uniform is nothing more than a "blank white pleated skirt and crop top." Pet. App. 53a.

J.A. 272

This garment "may be appropriate attire for a match at the All England Lawn Tennis Club, but not for a member of a cheerleading squad." Pet. App. 53a.

That is because a plain, white skirt and crop top do not cause an observer to perceive the wearer as a cheerleader or a member of a cheerleading team.

Moving to the identified-separately requirement, can the stripes, chevrons, zigzags, and color blocks be recognized apart from a cheerleader uniform's utilitarian aspects? No, for several reasons. As Varsity's lead designer explained, stripes, chevrons, zigzags, and lines are all "basic elements" of cheerleading uniform design. J.A. 305. This conclusion is logical, as "[m]ost cheerleading designs use diagonals, curves, lines and bright colors to achieve the function of identifying the person wearing it as a cheerleader" and as a particular team's member. Sarabia Decl. ¶¶ 10–11, Pg. ID 2180–81. Indeed, this Court has recognized (in the patent context) that a "product design which has a particular appearance may be functional because it is 'essential to the use or purpose of the article.' " *TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23, 35 (2001) (quotation omitted). That is particularly true here, where viewing the color blocks, stripes, etc. as a unit *depicts a cheerleader uniform*:

J.A. 82-83.

And a uniform in black, without the blocks and stripes, looks exactly like the ubiquitous little black dress:

See J.A. 81 (Design 0815).

The features and the useful article are one and the same.

The features cannot be identified separately for additional reasons that make them particularly useful for a cheerleader uniform. The braiding defining the uniform's outline has the effect of drawing a viewer's attention to the overall configuration of the uniform. The matching stripes on the skirt and top bring the two pieces together. The arrangement of all the features draws attention to where the school name or logo will be placed. In the words of the Copyright Act, the features cannot be recognized as a unit by themselves "separately from the utilitarian aspects of the article." 17 U.S.C. § 101.

This functionality is particularly true of the cut-and-sew uniforms that Varsity sued to enjoin Star Athletica from making. A cut-and-sew uniform's stripes cover the outward-facing seams that connect the colored panels. J.A. 355. So does the braiding (the striped fabric strips on all of the uniform designs). *Ibid.* Braiding also serves to create style lines and to minimize the stretching of neck and waist openings while strengthening the neck and

waist hems and hem stitching (which, again, is hidden under the braid). J.A. 356–57. And the braiding establishes the contours of the cheerleading uniform's shape. J.A. 32, 70, 81–83. Like the arrangement of the prom dress's decorative elements in *Jovani*, and the casino-uniform features in *Galiano*, none of the decorative features here can be recognized apart from the cheerleader uniform's utilitarian aspects. They are unified. Thus Varsity's uniform features cannot be copyrighted, and there is no need to conduct the exists-independently analysis.

But turning to the exists-independently requirement, can the uniform features and the uniform itself exist side by side and be perceived as fully realized, separate works, one artistic and the other useful? Considering physical separability first, the uniform features are not physically separable. On one side, you would have a collection of stripes, chevrons, and color blocks that still shout "cheerleader uniform," not "nonfunctional artistic arrangement of colors and stripes." On the other, you would have a plain, white top and skirt with exposed seams, diminished structural integrity, no effect on how the wearer is identified, and a detrimental effect on how the wearer's body is perceived.

As for design process, the objective evidence is conspicuous. On the creative-environment spectrum, Varsity's employees were not creating abstract art for a museum; they were hired to create cheerleader-uniform designs, Pet. App. 73a, their own original designs or copies of competitors, see J.A. 188. On the creative-independence spectrum, Varsity's employees did not have the freedom to create without limitations of shape and form; they began the process *by sketching a design over an outline of a cheerleader*

Pet. App. 60a. Unsurprisingly, each design produced is of a three-dimensional cheerleading uniform—not an abstract two-dimensional form. *Id.*; J.A. 324–38. And the features hew precisely to the contours of the uniform shape and to the seams they need to cover, all dictated by the wearer's body. J.A. 355–56. So much so, that if the uniform size changes, the features must be changed in size or the features will be out of proportion and look ridiculous (e.g., stripes and chevrons that stop short of the uniform seams). That is not true of a Piet Mondrian painting printed on a garment, which need not even be re-sized as the garment gets smaller or larger. Like the artist who modified his wire sculpture so that it could serve the functionality of a bike rack, Varsity's designs are driven by utilitarian pressures, not solely by artistic judgment. In this respect, Varsity's designs are just like the casino-uniform design features that the Fifth Circuit held could not be copyrighted in *Galiano*. And if the features are even only slightly utilitarian, this is dispositive.

But turning to marketability, it is certainly conceivable that if Varsity's stripes, chevrons, and color blocks stood on their own, *someone* might buy that "art." But it is not possible to say that such art would be marketable to a significant segment of the community *simply for its aesthetic qualities independent of the function of identifying and drawing attention to a cheerleader*. The "draw" of the features, whether hanging on the wall or printed on a t-shirt or smartphone case, is their ability to evoke a cheerleader uniform. That is why the market for cheerleader uniforms is in the hundreds of millions of dollars while the market for hang-on-the-wall stripes, chevrons, and color blocks *qua* stripes, chevrons, and color blocks is nonexistent.

In sum, the uniform features cannot exist independently of the uniform's utilitarian aspects. And if the Court thinks the question is a close one, it should come down on the side of noncopyrightability. rather than granting Varsity a century of copyright-monopoly protection in more than 200 cheerleader-uniform designs. The Copyright Clause gives Congress the power to grant such a monopoly to promote the progress of science and the useful arts for the public's good. But all the relevant history demonstrates that Congress has concluded that the public good does not require copyright protection for garment design.

Regarding garment design, Varsity's brief opposing the petition argued that Varsity's copyrights are for fabric designs, not garment designs. That is incorrect. When one goes to a fabric store and purchases a bolt of material with a pattern on it, *that* is a fabric design; in contrast, Varsity's designs are of actual cheerleading uniforms.

Varsity's fabric-design argument is belied by Varsity's deposit material for the registered designs, which consisted of sketches of a model wearing a cheerleading uniform and photographs of completed uniforms, all of which depict neck holes, arm holes, hems, and sides. R.169-2, Sarabia Decl. ¶ 8, Pg. ID 2179. It is belied by Varsity's admission that the analytically indistinguishable casino-uniform designs at issue in *Galiano* were in fact "garment designs." See Pet. Reply 7–8; Br. in Opp. 15. It is belied by Varsity's advertisements to the market, which claimed that Varsity's "*original uniform designs*" were copyright protected. J.A. 176–81. And it is belied by Varsity's threats against competitors infringing on Varsity's "right, title and interest in

and to certain garment designs, each of which is an original creation and constitutes copyrightable subject matter." J.A. 171. After all, Varsity is the nation's largest cheerleading-uniform manufacturer, not a manufacturer of two-dimensional drawings of cheerleading uniforms or even a manufacturer of bolts of fabric with cheerleader designs.

In sum, Varsity's copyright-infringement claim unequivocally involves the design of useful articles, i.e., cheerleader uniforms, not fabric designs, and the features of those uniforms are inseparable from the utilitarian function of the uniforms themselves.

IV. Errors in the Sixth Circuit panel majority's analysis

When measured against the statutory text as analyzed above, the Sixth Circuit panel majority erred in granting Varsity century-long protection in its industrial cheerleader-uniform designs.

1. The panel majority erred in giving *Skidmore* deference to the Copyright Office's registration determination and placing the burden on Star Athletica "to overcome the presumption," Pet. App. 15a–22a (citing *Skidmore* v. *Swift & Co.*, 323 U.S. 134 (1944)), while declining to defer to the Copyright Office's policy that garment designs are not copyrightable. In so doing, the panel majority conflated the eligibility of Varsity's drawings and photos for copyright registration (which Star Athletica does not contest), and Varsity's ability to use its registrations to prevent Star Athletica from manufacturing actual cheerleading uniforms.

This point was made many years ago in *Jack Adelman, Inc.* v. *Sonners & Gordon, Inc.*, 112 F.

Supp. 187 (S.D.N.Y. 1934). There, a district court confronted a similar argument by a garment manufacturer who wanted to use its sketch of a dress to prevent competitors from manufacturing that dress. *Id.* at 188. The court explained, "[a] dress is not copyrightable. A picture of a dress is." *Id.* at 189–90. And the copyright in the picture (i.e., a two-dimensional design) does not extend to the object pictured. *Id.* at 190. This limit on the *scope* of a copyright registration (not on copyright registrability) was incorporated by reference into the Copyright Act of 1976 when Congress preserved pre-1978 jurisprudence governing the scope of copyright protection for depictions of useful articles in 17 U.S.C. § 113(b). Thus, courts should not interpret § 101 in such a way as to violate the principle set forth in *Jack Adelman*.

The same point was reiterated more recently in *Eliya, Inc.* v. *Kohl's Dep't Stores*, 2006 WL 2645196 (S.D.N.Y. 2006) (Lynch, J.). Eliya, a shoe designer and manufacturer, sued Kohl's Department Stores, alleging that Kohl's copied one of Eliya's copyrighted shoe drawings. *Id.* at *1. Echoing *Jack Adelman*, the district court clarified that Eliya had "no copyright in an actual shoe, only a two-dimensional representation of one." *Id.* at *8. In other words, "ownership of a copyright in a pictorial representation of a useful article does not vest the owner of the picture with a derivative copyright in the useful article itself." *Id.* at *9. Indeed, if "such roundabout copyrighting were permitted, copyright law's exclusion of useful articles would be eviscerated, because any useful article could be copyrighted by merely obtaining a copyright for a two-dimensional representation of the article." *Ibid.*

Here, Varsity claims copyrights in two-dimensional drawings of three-dimensional cheerleader uniforms. Yet Varsity is attempting to use its copyrights to prevent Star Athletica from manufacturing actual three-dimensional cheerleading uniforms. To prevail, it is *Varsity's* burden, not Star Athletica's, to prove that the scope of its copyrights extends to the three-dimensional uniforms. And that requires Varsity to prove separability. It does not require Star Athletica to overcome the presumptive validity of Varsity's registration in two-dimensional sketches and photographs of its uniforms.

2. The panel majority stumbled in its approach to defining a cheerleader uniform's intrinsic functions, i.e., the natural, essential, or inherent nature of a cheerleading uniform. The majority's error flowed from its belief that " '[p]ortray[ing] the appearance of the [useful] article' and 'convey[ing] information' are two utilitarian aspects that courts may *not* use to determine whether pictorial, graphic, or sculptural features are separable." Pet. App. 38a (citing 17 U.S.C. § 101) (emphasis added). That statement misconstrues the statutory text, because, as noted above, § 101 does not say a useful article cannot convey information; it says that an article that "merely" conveys information is not a useful article (and is therefore copyrightable). For example, a billboard or a sign conveys information and nothing more. These are not useful articles. In contrast, and as the panel majority acknowledged, a cheerleader uniform does not "merely" identify; it has a number of inherently useful functions. Accordingly, the uniform is a useful item, and *all* of its functionality, viewed in the light of its intended purpose and use, must be evaluated to

determine whether the uniforms' features have even the slightest utilitarian function.

3. The panel majority made a mistake in declining to consider the objective evidence regarding why and how the Varsity designers created their designs "to the exclusion of other evidence." Pet. App. 40a–41a. As explained above, it should be dispositive here that Varsity's employees made cheerleader uniforms for a cheerleader manufacturer, started the design process by sketching over an outline of a cheerleader, and conforming the design features to the contours and function of a cheerleader uniform. The composition of stripes, chevrons, and color blocks is not merely decorative, but also serve to affect the perception of the wearer's dimensions. To hold otherwise is to ignore Congress's intent to exclude industrial design from the Copyright Act's scope.

4. The panel majority blundered by rejecting altogether the likelihood-of-marketability test. Pet. App. 41a. Consideration of the marketability of stripes, chevrons, and color blocks *qua* stripes, chevrons, and color blocks (there is none) demonstrates that these design features and the utilitarian aspects of a cheerleader uniform cannot be separated.

5. The panel majority miscited Star Athletica as arguing that pictorial, graphic, and sculptural features are always "inextricably intertwined with the utilitarian aspects of a cheerleading uniform because they serve a decorative function." Pet. App. 43a–44a. Star Athletica could concede that if Varsity had a copyright in *The Starry Night* painting, Varsity could print a copy of that painting (in any size it desired) on a uniform, and the print would still be copyrightable. But, as explained above, that

scenario is 180 degrees from how the stripes, chevrons, and color blocks appeared on Varsity's actual uniform designs here. It ignores that Varsity's designers were creating cheerleader uniforms, not abstract works of art; that the designs hewed to the outline of cheerleaders; and that the features and the uniform cannot be identified separately (as can *The Starry Night* and the uniform) or exist independently (same).

6. The panel mistakenly conflated Varsity's claimed copyright in its uniform design with "fabric designs." Pet. App. 44a. As also explained above, this is not and has never been a fabric-design case, which is why Varsity's initial Sixth Circuit brief devoted more than 30 pages to the relative merits of the various separability tests and their application to this case, and zero pages to fabric design. R.24, Appellant's Br. 31–62.

7. The panel majority got it wrong when it said that Varsity's designs "do not 'enhance the [cheerleading uniform's] functionality *qua* clothing,' " because a "plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip." Pet. App. 45a. The majority could have made the exact same statement about a plain white gymnastics leotard or wrestling singlet. Yet no one would look at a person wearing a leotard or singlet and conclude that person was a cheerleader or a member of a specific cheer team.

8. The panel majority reasoned that nothing (except perhaps good taste) prevents Varsity from framing its designs on the wall as art. Pet. App. 47a. This debases the marketability consideration that

the majority previously disavowed. If applied literally, then every design feature ever created can be copyrighted. (One could certainly frame the stripes, color blocks, and star-shaped buttons of a casino uniform, hang them on the wall, and sell them as art.) Under Nimmer's *actual* marketability test, the question is whether the design features could be marketed to a *significant* segment of the community *simply because of their aesthetic qualities*. And as already explained, there is no reason to think that is the case with respect to Varsity's design features.

9. Again confusing garment design (which is at issue here) with fabric design (which is not)—the majority attempted to reconcile its conclusion here with that of other circuits analyzing garment-design separability. The majority said that "the creative arrangement of sequins, beads, ribbon, and tulle, which form the bust, [sic] waistband of a [prom] dress, do not qualify for copyright protection because each of these elements (bust, waistband, and skirt) all serve to clothe the body." Pet. App. 49a (citing *Jovani*). But in the majority's world, these design features are not actually necessary to cover the body; the prom dress itself can do that. The Second Circuit in *Jovani* concluded these features were not copyrightable because the features enhanced the dress's functionality as clothing for special occasions and were designed to advance that functionality. 500 F. App'x at 45. Some of the features form the dress's configuration, and all of them draw the viewer's attention to the wearer.

The panel majority here similarly said the casino-uniform stripes, color blocks, and star-shaped buttons in *Galiano* were uncopyrightable because these features "are merely inventive designs used to

cover the wearer's body." Pet. App. 49a–50a. Not so. The uniform itself covered the wearer's body. The Fifth Circuit concluded these features were not copyrightable because they were not marketable independent of their utilitarian function as casino uniforms. 416 F.3d at 421–22.

In sum, at nearly every step of the analysis, the Sixth Circuit panel majority departed from the statutory text and the logic of other cases. Once it is understood that this is a case about uniform design, not fabric design, and that a cheerleader uniform has more utilitarian functionality than merely allowing the wearer to kick and flip, the separability indicators all point to the nonprotectability of Varsity's uniform-design features. The panel majority's holding effectively grants Varsity a century-long cheerleader-uniform-design monopoly, the very result Congress has persistently rejected for more than 100 years by refusing to extend copyright protection to garment design. This Court should align itself with Congress and decline to adopt the so-called "Sixth Circuit approach" or any approach that would allow a century-long cornering of any aspect of the garment market based simply on a company's copyright registration of a two-dimensional garment drawing.

The point of the Copyright Clause is to encourage innovation and the creation of original works. But the fashion industry already has that. There are many market participants, intense competition, and a race to release new designs. It is a paradigm of an area that does not need a government-granted monopoly to promote output and creativity. See Kal Raustiala, Christopher Sprigman, *The Piracy Paradox Revisited*, 61 Stan. L. Rev. 1201, 1213 (2009).

Thus, it should be no surprise that Congress has declined every invitation to extend copyright protection to garment design, even for periods as short as three years, much less a century. This Court should reject Varsity's overture to overturn Congress's apparent policy choice that the fashion-design industry does not warrant even copyright-lite protection. As the district court ruled, Star Athletica is entitled to judgment as a matter of law.

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted,

JOHN J. BURSCH
Counsel of Record
MATTHEW T. NELSON
CONOR B. DUGAN
WARNER NORCROSS & JUDD LLP
900 Fifth Third Center
111 Lyon Street, N.W.
Grand Rapids, MI 49503
(616) 752-2000
jbursch@wnj.com

Steven M. Crosby
THE FELDMAN LAW GROUP
220 East 42nd Street,
Suite 3004
New York, NY 10017

Michael F. Rafferty
Emily Hamm Huseth
HARRIS SHELTON HANOVER
WALSH P.L.L.C.
One Commerce Square,
Suite 2700
Memphis, TN 38103

Counsel for Petitioner

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17 U.S.C. § 101
§ 101. Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

An "anonymous work" is a work on the copies or phonorecords of which no natural person is identified as author.

An "architectural work" is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.

"Audiovisual works" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines, or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

The "Berne Convention" is the Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.

The "best edition" of a work is the edition, published in the United States at any time before the date of

deposit, that the Library of Congress determines to be most suitable for its purposes.

A person's "children" are that person's immediate offspring, whether legitimate or not, and any children legally adopted by that person.

A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

"Copyright owner", with respect to any one of the exclusive rights comprised in a copyright, refers to the owner of that particular right.

A "Copyright Royalty Judge" is a Copyright Royalty Judge appointed under section 802 of this title, and includes any individual serving as an interim Copyright Royalty Judge under such section.

A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

A "device", "machine", or "process" is one now known or later developed.

A "digital transmission" is a transmission in whole or in part in a digital or other non-analog format.

To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images nonsequentially.

An "establishment" is a store, shop, or any similar place of business open to the general public for the primary purpose of selling goods or services in which the majority of the gross square feet of space that is nonresidential is used for that purpose, and in which nondramatic musical works are performed publicly.

The term "financial gain" includes receipt, or expectation of receipt, of anything of value, including the receipt of other copyrighted works.

A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

A "food service or drinking establishment" is a restaurant, inn, bar, tavern, or any other similar place of business in which the public or patrons assemble for the primary purpose of being served food or drink, in which the majority of the gross square feet of space that is nonresidential is used for that purpose, and in which nondramatic musical works are performed publicly.

The "Geneva Phonograms Convention" is the Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms, concluded at Geneva, Switzerland, on October 29, 1971.

The "gross square feet of space" of an establishment means the entire interior space of that establishment, and any adjoining outdoor space used to serve patrons, whether on a seasonal basis or otherwise.

The terms "including" and "such as" are illustrative and not limitative.

An "international agreement" is--

(1) the Universal Copyright Convention;

(2) the Geneva Phonograms Convention;

(3) the Berne Convention;

(4) the WTO Agreement;

(5) the WIPO Copyright Treaty;

(6) the WIPO Performances and Phonograms Treaty; and

(7) any other copyright treaty to which the United States is a party.

A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

"Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

The term "motion picture exhibition facility" means a movie theater, screening room, or other venue that is being used primarily for the exhibition of a copyrighted motion picture, if such exhibition is open to the public or is made to an assembled group of viewers outside of a normal circle of a family and its social acquaintances.

"Motion pictures" are audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.

To "perform" a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.

A "performing rights society" is an association, corporation, or other entity that licenses the public performance of nondramatic musical works on behalf of copyright owners of such works, such as the American Society of Composers, Authors and Publishers (ASCAP), Broadcast Music, Inc. (BMI), and SESAC, Inc.

"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

For purposes of section 513, a "proprietor" is an individual, corporation, partnership, or other entity, as the case may be, that owns an establishment or a food service or drinking establishment, except that no owner or operator of a radio or television station licensed by the Federal Communications Commission, cable system or satellite carrier, cable or satellite carrier service or programmer, provider of online services or network access or the operator of facilities therefor, telecommunications company, or any other such audio or audiovisual service or programmer now known or as may be developed in the future, commercial subscription music service, or owner or operator of any other transmission service, shall under any circumstances be deemed to be a proprietor.

A "pseudonymous work" is a work on the copies or phonorecords of which the author is identified under a fictitious name.

"Publication" is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.

To perform or display a work "publicly" means--

(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.

"Registration", for purposes of sections 205(c)(2), 405, 406, 410(d), 411, 412, and 506(e), means a registration of a claim in the original or the renewed and extended term of copyright.

"Sound recordings" are works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless

of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied.

"State" includes the District of Columbia and the Commonwealth of Puerto Rico, and any territories to which this title is made applicable by an Act of Congress.

A "transfer of copyright ownership" is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.

A "transmission program" is a body of material that, as an aggregate, has been produced for the sole purpose of transmission to the public in sequence and as a unit.

To "transmit" a performance or display is to communicate it by any device or process whereby images or sounds are received beyond the place from which they are sent.

A "treaty party" is a country or intergovernmental organization other than the United States that is a party to an international agreement.

The "United States", when used in a geographical sense, comprises the several States, the District of Columbia and the Commonwealth of Puerto Rico, and the organized territories under the jurisdiction of the United States Government.

For purposes of section 411, a work is a "United States work" only if—

(1) in the case of a published work, the work is first published--

(A) in the United States;

(B) simultaneously in the United States and another treaty party or parties, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States;

(C) simultaneously in the United States and a foreign nation that is not a treaty party; or

(D) in a foreign nation that is not a treaty party, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States;

(2) in the case of an unpublished work, all the authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States; or

(3) in the case of a pictorial, graphic, or sculptural work incorporated in a building or structure, the building or structure is located in the United States.

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the

appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".

The author's "widow" or "widower" is the author's surviving spouse under the law of the author's domicile at the time of his or her death, whether or not the spouse has later remarried.

The "WIPO Copyright Treaty" is the WIPO Copyright Treaty concluded at Geneva, Switzerland, on December 20, 1996.

The "WIPO Performances and Phonograms Treaty" is the WIPO Performances and Phonograms Treaty concluded at Geneva, Switzerland, on December 20, 1996.

A "work of visual art" is--

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include--

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

A "work of the United States Government" is a work prepared by an officer or employee of the United States Government as part of that person's official duties.

A "work made for hire" is--

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be

> considered a work made for hire. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

In determining whether any work is eligible to be considered a work made for hire under paragraph (2), neither the amendment contained in section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, nor the deletion of the words added by that amendment—

> (A) shall be considered or otherwise given any legal significance, or
>
> (B) shall be interpreted to indicate congressional approval or disapproval of, or acquiescence in, any judicial determination,

by the courts or the Copyright Office. Paragraph (2) shall be interpreted as if both section 2(a)(1) of the Work Made For Hire and Copyright Corrections Act of 2000 and section 1011(d) of the Intellectual

Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, were never enacted, and without regard to any inaction or awareness by the Congress at any time of any judicial determinations.

The terms "WTO Agreement" and "WTO member country" have the meanings given those terms in paragraphs (9) and (10), respectively, of section 2 of the Uruguay Round Agreements Act.

17 U.S.C. § 102
§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.